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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,201	07/24/2006	Simon Michael West	22380-013US1 / FP24061	4065
26161 7590 01/24/2008 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1625	
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			01/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,201

Applicant(s)

WEST ET AL.

Examiner

Taofiq A. Solola

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: ____ |

Claims 1-17 are pending in this application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16-17 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Under US patent practice, a use claim without setting forth the steps involved in the process is an improper definition of a process, under 35 U.S.C. See *Ex parte Dunki*, 153 USPQ 678 (Bd. App, 1967) and *Clin. Products v. Brenner*, 149 USPQ 475 (D.D.C., 1966). By deleting the claim the rejection would be overcome.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over West, WO 00/69865 [West I], West et al., WO 02/40034 [West II] and Manning et al., US 5,981,474, individually.

Applicant claims phosphate derivatives of known therapeutic compounds comprising the derivatives, and a complexing agent. The compounds have phenol, primary alcohol, secondary alcohol or tertiary hydroxyl group. In preferred embodiments the phosphate is phosphatide.

Determination of the scope and content of the prior art (MPEP 2141.01)

West I teaches phosphate derivatives of primary fatty alcohols, secondary alcohols and aromatic alcohols and their compositions. West II teaches composition comprising phosphate

derivatives of hydroxylated compounds and complexing agents. Manning et al., teach phosphate derivatives of known compounds. The phosphate may be phospholipids. See col. 5-6.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of the prior arts is that applicant compositions comprise specific therapeutic agents.

Finding of prima facie obviousness--rational and motivation (MPEP 2142.2413)

However, the generic compounds of West I and West II embrace the specific therapeutic compounds by applicant. Making phosphate derivative of any therapeutic drug is an obvious modification available to the preference of an artisan. Therefore, the instant invention is prima facie obvious from the teachings of the prior arts. One of ordinary skill in the art would have known to make phosphate derivative of any therapeutic drug of choice at the time the invention was made. The motivation is from the teachings of the prior arts.

Alternatively, given the teachings of the prior arts it would have been obvious to try and make phosphate derivative of any therapeutic drug of choice, particularly drugs having OH group, at the time the invention was made.

When there is motivation

to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [35 USC] 103.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct 1727,-----, 82 USPQ2d 1385, 1397 (2007).

Alternatively, the therapeutic compounds, phosphate and complexing agents are not applicant's invention. They are in the public domain prior to the time the instant invention was made. Applicant has done no more than combine separate but well-known inventions. While the combination may perform a useful function it did no more than what they would have done separately. *In re Anderson*, 396 U.S. 57, 163 USPQ 673 (1969) cited in *KSR Int. Co. v. Teleflex Inc.*, 550 U.S. ----, 82 USPQ2d 1385 (2007). When a patent simply arranges old elements with each performing the same function it had been known to perform and yields predictable result, the combination is obvious. *In re Sakraida*, 425 US 273, 189 USPQ 449 (1976) cited in *KSR, supra*. A patent for such combination "obviously withdraws what is already known into the field of its monopoly." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 187 USPQ 303 (1950), cited in *KSR, supra*.

Alternatively, given the teachings of the prior arts one would have known to make compositions comprising phosphate derivatives of any compounds having OH group at the time the invention was made. "When a work is available in one field of endeavour, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technology is obvious unless its actual application is beyond his or her skill." "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR Int. Co. v. Teleflex Inc.*, 550 U.S. ----, 82 USPQ2d 1385 (2007).

Alternatively, applicant has done nothing more than substitutes therapeutic drugs having OH group. However, such substitution is obvious from the prior arts. "When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *United States v. Adams*, 383 U.S. 49, 50-51 (1966). Cited in *KSR Int. Co. v. Teleflex Inc.*, 550 U.S. ----, 82 USPQ2d 1385 (2007). The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR, supra*.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1625

January 17, 2008